



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/775,206
Applicant : HUBBARD, ET AL.
Filed : FEBRUARY 11, 2004
Title : THERMOPLASTIC-TYPE COVERING SYSTEMS WITH PRE-APPLIED
ADHESIVE

Art Unit : 1771
Examiner : ZIRKER, DANIEL R.

Atty Docket No. : BFSD -0010-UT1

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Commissioner for Patents
P.O. Box 1450
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REQUEST FOR PRE-APPEAL BRIEF REVIEW

Sir:

In conjunction with the Notice of Appeal concurrently filed for the above application involving Claims 14 and 18-31 on appeal, Applicant respectfully requests a Pre-Appeal Brief Review further to the Official Gazette Notice of July 12, 2005 and the January 10, 2006 Extension thereof which authorizes Pre-Appeal Brief Conferences.

I. Basis for Request for Review.

This request is necessitated by: (1) the Examiner's failure to establish a *prima facie* case of obviousness in the October 17, 2006 Final Office Action (Final Office Action) in rejecting Claims 14 and 18-31 over U.S. Patent No. 6,794,449 to Fischer (Fischer), taken either individually, or in view of Applicant's alleged admissions on page 1, paragraph [0003] of the specification (Paragraph [0003]); (2) the Examiner making a new allegation in the Advisory Action that effectively admits that the rejection of Claims 18-20 and 28-31 in the Final Office Action is *prima facie* improper; and (3) the Examiner making an arbitrary and capricious objection under 35 U.S.C. § 132 of Applicant's amendments to paragraph [0047] of the specification.

A. The Examiner has failed to establish a *prima facie* case of obviousness in the Final Office Action in rejecting Claims 14 and 18-31 over Fischer, taken either individually or in view of Paragraph [0003].

As Applicant discussed in detail in Section C of Applicant's December 14, 2006 Amendment After Final (Amendment After Final), the Examiner has failed to establish a *prima facie* case of obviousness in rejecting Claims 14 and 18-31 over Fischer, taken either individually or in view of Paragraph [0003] in the Final Office Action (See Amendment After Final, Section C, pp. 6-11). As discussed in Applicant's Amendment After Final, the Final Office Action mischaracterizes Applicant's arguments in Applicant's August 7, 2006 Amendment (Applicant's August Amendment) (See Amendment After Final, Section C, pp. 6-11). Also, because the Final Office Action mischaracterizes Applicant's arguments, the Final Office Action has failed to rebut Applicant's arguments in Applicant's August Amendment that the combination of cited references do not teach or suggest all of the features of Claims 14 and 21-27 (See Amendment After Final, Section C(4) to C(7), pp. 7-9). The Final Office Action also fails to rebut Applicant's arguments in Applicant's August Amendment that the combination of cited references do not teach or suggest all of the features of Claims 18-20 and 28-31 (See Amendment After Final, Section C(8) to C(11), pp. 10-11).

For at least the above reasons, the Examiner has failed to make a *prima facie* case of obviousness in rejecting Claims 14 and 18-31 over Fischer, taken either individually or in view of Paragraph [0003] in the Final Office Action.

The Examiner's comments in the January 10, 2007 Advisory Action does not address the numerous deficiencies in the rejection of Claims 14 and 18-31 over Fischer and Paragraph [0003] in the Final Office Action. Just as in the Final Office Action, the Examiner fails in the Advisory Action to show how the cited references teach or suggest, alone or in combination, the following feature of Claims 14 and 21-27: (1) *adhering two or more building structure peripherals to one or more thermoplastic membranes using a pre-applied adhesive* as claimed by. Also, just as in the Final Office Action, the Examiner fails in the Advisory Action to show how the cited references, either alone or in combination, teach or suggest the following feature of Claims 18-20 and 28-31: (2) *adhering universal flashing to two or more surfaces that are at one or more angles to each other using a pre-applied adhesive*.

B. The Examiner Makes a New Allegation in the Advisory Action that Effectively Admits that the Rejection of Claims 18-20 and 28-31 in the Final Office Action is *Prima Facie* Improper.

In the Advisory Action, the Examiner makes a new allegation that as to feature (2) above in Claims 18-20 and 28-31:

Allegation 1

... the Examiner must respectfully note that it is believed to be within the skill of the art as regards to how the flashing, i.e. roofing segment is applied to the substrate.

But Allegation 1 has never been made before during the prosecution of the present application. Furthermore, the fact that the Examiner believes that Allegation 1 is necessary to establish a *prima facie* case of obviousness *effectively admits that the Examiner believes that he did not establish a prima facie of obviousness in the Final Office Action*. In fact, the Examiner has so far provided no evidence for Allegation 1 either in the Final Office Action or in the Advisory Action.

Therefore, if the Examiner wishes to use Allegation 1 to reject the pending claims, the Examiner should re-open prosecution to provide evidence in support of this *new allegation* and to allow the Applicant a reasonable and fair opportunity to rebut this new allegation. In addition, Applicant notes that in both in the Final Office Action and in the Advisory Action, the Examiner has failed to show how the cited references, either alone or in combination, teach or suggest the feature of *adhering universal flashing to two or more surfaces that are at one or more angles to each other using a pre-applied adhesive, wherein the two or more surfaces are part of one or more thermoplastic membranes affixed to a building structure* as claimed by Claim 18-20 and 28-31. Therefore, upon re-opening prosecution, in order for Allegation 1 to have any relevance, the Examiner will need to provide evidence showing that it is within the skill of the art to adhere *universal flashing to two or more surfaces that are at one or more angles to each other using a pre-applied adhesive, wherein the two or more surfaces are part of one or more thermoplastic membranes affixed to a building structure*.

C. The Examiner's objection under 35 U.S.C. § 132 to the Applicant's amendments to paragraph [0047] of the specification is arbitrary and capricious.

In the Final Office Action, Applicant's amendments to paragraph [0047] in Applicant's August 7, 2007 Amendment (Applicant's August Amendment) were objected to under 35 U.S.C. § 132. The last two lines of paragraph [0047] of the application as originally filed read as follows:

Suitable pipe boots includes the EPDM or TPO peel-and-stick pipe boots, with included clamping rings, made by GenFlex™.

In Applicant's August Amendment, the last two lines of paragraph [0047] were amended to read as follows:

Suitable pipe boots include the EPDM or TPO GenFlex™ Peel & Stick™ pipe boots, with included clamping rings, made by GenFlex Roofing Systems" (see Applicant's August Amendment, p. 3).

Regarding the two lines as amended above, the Examiner stated the following in the Final Office Action:

. . . the phrases “GenFlex™ Peel & Stick™ and “GenFlex Roofing Systems” are each believed to be new matter because no express support exists for either phrase and no inherent support has been pointed out or is otherwise believed to exist (see Final Office Action, p. 2).

In Applicant’s After Final Amendment of December 14, 2006, Applicant attempted to amend paragraph [0047] back to the language of paragraph [0047] as originally filed. However, Applicant inadvertently made the following changes to the last two lines of paragraph [0047] as originally filed: (1) changed “EPDM or TPO peel-and-stick pipe boots” to read “EPDM or TPO pipe boots”; and (2) changed “GenFlex™” to read “GenFlex™ Roofing Systems.” Other than these two minor changes, paragraph [0047] in Applicant’s Amendment After Final and paragraph [0047] as originally filed are identical.

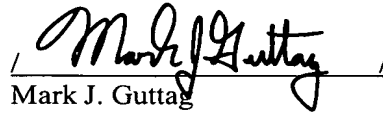
Nevertheless, in the January 10, 2007 Advisory Action (Advisory Action), the Examiner states that “the last two lines contain differences from those which were filed, and as such clearly appear to still contain new matter.” But Applicants fail to understand how either the elimination of the words “peel-and-stick “ or providing the full name of the company that produces the pipe boots referenced in paragraph [0047] constitutes “new matter.” The Examiner’s objection to even these minor clarifying amendments to paragraph [0047] is clear evidence that the Examiner has arbitrarily and capriciously objected to these amendments to paragraph [0047].

II. Relief Requested.

For at least the reasons discussed above: (1) the Examiner has failed to establish a *prima facie* case of obviousness in the Final Office Action in rejecting Claims 14 and 18-31 over Fischer, taken either individually, or in view of Paragraph [0003]; (2) the Examiner has made a new allegation in the Advisory Action that effectively admits that the rejection of Claims 18-20 and 28-31 in the Final Office Action is *prima facie* improper; and (3) the Examiner has made an arbitrary and capricious objection under 35 U.S.C. § 132 to Applicant’s amendments to paragraph [0047] of the specification.

Therefore, Applicants hereby request: (1) that all of the objections to the specification and all of rejections of pending Claims 14 and 18-31 be withdrawn, and thus pending Claims 14 and 18-31 should be allowed; or (2) that prosecution be reopened to allow the Examiner to provide evidence supporting Allegation 1 above and to provide Applicants with a reasonable and fair opportunity to rebut Examiner's Allegation 1 upon reviewing the Examiner's evidence in support of Allegation 1.

Respectfully submitted,



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